

REMARKS

Claims 1-5 are all the claims now pending in the application. Claims 6-24 have been canceled without prejudice or disclaimer.

Claims 1-3 and 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Higuchi (U.S. Patent No. 5,704,854). Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the references applied in claim 1 above, in view of Sullivan (U.S. Patent No. 5,688,869).

To be an “anticipation” rejection under 35 U.S.C. § 102, the reference must teach every element and limitation of the Applicant’s claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the reference must clearly and unequivocally disclose every element and limitation of the claimed invention. Applicant submits that the Higuchi reference fails to teach or suggest an intermediate layer having a Shore D hardness of 53 to 65 and a cover having a Shore D hardness of 37 to 50.

The Examiner argues that although Higuchi does not teach that the intermediate layer is harder than the cover, Higuchi does teach the claimed hardness range for both the intermediate layer and the cover, and thus, the claims are anticipated by Higuchi. Applicant submits that this conclusion is not taught or supported by the Higuchi reference. Higuchi teaches that the IML must be softer than the cover by 2-20 Shore D degrees. See Higuchi, col. 3:45-53. Claim 1 recites an intermediate layer having a Shore D hardness of 53-65 while Higuchi teaches an intermediate layer having a Shore D hardness of 30-55. Accordingly, the only values taught by

Higuchi which fall within the claimed range are when the intermediate layer Shore D hardness is 53, 54, or 55. Since Higuchi teaches that the intermediate layer is 2-20 Shore D degrees less than the cover hardness, based on intermediate layer Shore D hardness values of 53-55, the cover Shore D hardness of Higuchi would be at least 55-57, which is outside the claimed range of 37-50. In essence, the Examiner is ignoring the teaching of Higuchi that the intermediate layer must be softer than the cover hardness, which is the opposite relationship that is recited in claim 1. Instead, the Examiner is looking only to pieces of the teachings of Higuchi and not considering the teachings of Higuchi as a whole. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP §2141.02 citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (emphasis in original). When taken as a whole, Higuchi clearly teaches that the cover must be harder than the intermediate layer by 2-20 Shore D degrees, and thus, cannot teach the limitations recited in claims 1-3 and 5.

In view of the above remarks, Applicant respectfully requests that the rejection of claims 1-3 and 5 under 35 U.S.C. § 102(b) be reconsidered and withdrawn. Since claim 4 depends from claim 1, and since the Sullivan reference does not cure the deficient teachings of Higuchi with respect to claim 1, Applicant submits that claim 4 is patentable at least by virtue of its dependency from claim 1. Accordingly, Applicant respectfully requests that the rejection of claim 4 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

AMENDMENT UNDER 37 C.F.R. § 1.116
Appln. No.: 09/891,654

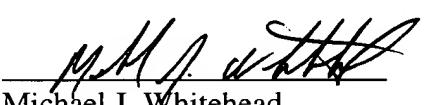
Attorney Docket No.: Q65201

Finally, claims 6-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimosaka et al. (U.S. Patent No. 5,816,937). However, since these claims have been canceled, the rejection is now moot.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Michael J. Whitehead
Registration No. 48,071

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE



23373

PATENT TRADEMARK OFFICE

Date: February 5, 2003

AMENDMENT UNDER 37 C.F.R. § 1.116
Appln. No.: 09/891,654

Attorney Docket No.: Q65201

APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 6-24 are canceled.